

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GLENN PETKOVSEK

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Appeal No. 2005-0952  
Application No. 09/908,282

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ON BRIEF

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Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 17. Claims 18 through 36, the only other claims pending in the application, have been withdrawn from further consideration.

Appeal No. 2005-0952  
Application No. 09/908,282

As noted on page 1 of appellant's specification, the present invention relates to a form for receiving printed information relating to recorded documents and, more specifically, to a form having a plurality of detachable parts capable of having information, such as, for example, user data, government data, and the like, printed thereon by a printer. Independent claim 1 is representative of the subject matter on appeal, and a copy of that claim can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Korondi, Jr. (Korondi)	5,702,127	Dec. 30, 1997
Amon et al. (Amon)	5,807,625	Sep. 15, 1998

Claims 1 through 9 and 12 through 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Korondi.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Korondi in view of Amon.

Appeal No. 2005-0952  
Application No. 09/908,282

Rather than reiterate the examiner's statement of the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we refer to the answer (mailed August 25, 2004) for the examiner's reasoning in support of the rejections and to the brief (filed June 18, 2004) for appellant's views to the contrary.

#### OPINION

Our evaluation of the issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have made the determination that the evidence relied upon by the examiner is sufficient to support a conclusion of obviousness under 35 U.S.C. § 103 with respect to appellant's claims 1 through 17. Our reasoning follows.

We look first to the examiner's prior art rejection of claims 1 through 9 and 12 through 17 under 35 U.S.C. § 103(a) based on Korondi. In that regard, the examiner contends that the label form (10) seen in Figures 1-3 of Korondi comprises a first

Appeal No. 2005-0952  
Application No. 09/908,282

layer (20) defined by a plane having front and back sides wherein the back side has a perimeter defined by exterior edges and further wherein the front side has a first label (32) and a second label (34); an adhesive layer (24) applied on the back side of the first layer (col. 4, lines 8-10 and col. 5, lines 18-24) wherein the adhesive layer covers the back side between the exterior edges defining the perimeter of the back side of the first layer; a backing layer (12) attached to the first layer by the adhesive layer, wherein the first and second labels (32, 34) on the front side of layer (20) receive printed information, and further wherein the adhesive layer separates from the backing layer and is attachable to a surface. Thus, the examiner is of the view that the physical structure of the label form in Korondi is the same as that of the form set forth in claim 1 on appeal.

Concerning the recitation in claim 1 that the information to be printed on the form is "electronically imaged information accessed over a global computer network wherein the electronically imaged information is necessary to comply with requirements for recording of the document," the examiner contends that such recitation does not structurally limit the claim, because the patentability of a product does not depend on

Appeal No. 2005-0952  
Application No. 09/908,282

its method of production, especially when, as in the present case, the source and content of the information to be printed on the form does not in any way provide an additional limitation on the physical structure of the claimed form. As for the recitation in claim 1 that the second label "is a receipt," and the recitations in dependent claims 2 through 9 and 12 through 17 regarding the content of the particular printed information applied to the first and/or second labels of the form, the examiner finds that such recitations are merely directed to the intended use of the form and/or to the specific arrangement or content of the printed matter applied to the form to facilitate such use. More particularly, the examiner has determined that the second label (34) of Korondi is capable of use as a receipt depending on the indicia printed on the label, and that the labels of appellant's invention merely serve as a support for the printed matter, with no novel and unobvious functional relationship between the printed matter and the substrate (labels). Based on such determinations, the examiner concludes that there is no reason to give patentable weight to the content of the recited printed matter which, by itself, is non-statutory subject matter.

Appeal No. 2005-0952  
Application No. 09/908,282

Like the examiner, the only differences we perceive between the label form of Korondi and that of appellant's claims 1 through 9 and 12 through 17 reside in the arrangement and/or content of the printed matter which is set forth as being received by and/or on one or the other of the first and second labels. As the examiner has already pointed out, the appropriate test for determining whether such printed matter is entitled to patentable weight is set forth in In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983), which states

[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight . . . .

. . . .

[w]hat is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. [Footnotes and citations omitted.]

Appeal No. 2005-0952  
Application No. 09/908,282

Applying this test in the present case, it is our opinion that the mere arrangement and content of the printed matter on appellant's first and second labels does not provide any new and unobvious functional relationship between the printed matter and the labels. The only functional relationship we perceive in appellant's claimed form is that the first and second labels act to support and carry the printed matter. This is, of course, the same relationship that exists between the printed matter and the labels in Korondi. The fact that the content or substance of the printed matter placed on the labels in appellant's form may be different than that placed on Korondi's labels does not alter the fact that the labels of both merely support the printed matter. Since we discern no new and unobvious functional relationship between the printed matter and the labels of appellant's claimed form, we are led to the same conclusion as the examiner, i.e., that such printed matter is not entitled to patentable weight when considered in light of the teachings of the applied prior art. Mere support by the substrate for the printed matter is simply not the kind of new and unobvious functional relationship necessary for patentability.

Appeal No. 2005-0952  
Application No. 09/908,282

Concerning appellant's arguments on pages 10-12 of the brief that Korondi does not teach a form wherein an adhesive layer covers the back side of the first layer between the exterior edges defining the perimeter of the back side of the first layer as required by claim 1 on appeal, we agree with the examiner's position set forth on pages 7-9 of the answer. In addition, we note that Korondi clearly indicates that the entire backside of the label ply or first layer (20) of the form therein is covered with a pressure sensitive adhesive (24) and that only after such an application of adhesive is a selected area beneath spacing strip (36) deadened or neutralized. Thus, the first layer (20) of Korondi initially has an adhesive layer which covers the back side of the first layer between the exterior edges defining the perimeter of the back side of the first layer, as required in claim 1 on appeal. Moreover, the fact that the adhesive layer is later deadened or neutralized in a selected area beneath spacing strip (36) of Korondi's form to eliminate the sticky characteristics of the adhesive in that area does not change the fact that a layer of adhesive is still present on the entire backside of the first layer, although rendered ineffective in the area beneath spacing strip (36).

Appeal No. 2005-0952  
Application No. 09/908,282

Since we are unable to accord the printed matter in claims 1 through 9 and 12 through 17 on appeal any patentable weight, and since the physical structure of Korondi's form is the same as that set forth in the claims on appeal, it follows that we will sustain the examiner's rejection of claims 1 through 9 and 12 through 17 under 35 U.S.C. § 103(a).

As for the rejection of claims 10 and 11 under 35 U.S.C. § 103(a) based on the combined teachings of Korondi and Amon, we share the examiner's view that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to use a security ink like that disclosed in Amon to print certain selected information or security marks on the labels (32, 34) of Korondi to provide a means for preventing forgery or counterfeiting of such labels. In that regard, we observe that Amon expressly notes (col. 6, lines 44-49) that the photochromic printing inks therein may be used on "labels and similar printed documents for which measures against counterfeiting are indicated."

Appeal No. 2005-0952  
Application No. 09/908,282

Appellant's comments on pages 26-29 of the brief have been considered, but provide no basis to change our determination regarding claims 10 and 11. While it is true that neither Korondi nor Amon provides an express teaching or suggestion of a form "for recording a document," we again note that such a future use of appellant's claimed form depends entirely on the content of the information printed on the respective first and second labels, and provides no new and unobvious functional relationship between the printed matter and the labels, and also no structural distinction between the form defined in the claims on appeal and the physical structure of the form disclosed in Korondi.

As for appellant's assertion on page 28 of the brief that "the Patent Office is merely 'piece-mealing' references together, providing various teachings and positively defined limitations of Appellant's method" (emphasis added), we note that the claims on appeal are directed to a form per se, and not to a method of using a particular form. Thus, it is the structural features of the form itself which must distinguish over the prior art in order to be patentable, or printed matter carried by the form

Appeal No. 2005-0952  
Application No. 09/908,282

must result in a new and unobvious functional relationship between the printed matter and the form. As we have indicated above, no such functional relationship exists in the present case.

In light of the foregoing, the examiner's rejection of claims 1 through 9 and 12 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Korondi has been sustained; and the examiner's rejection of claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Korondi in view of Amon has been sustained. Thus, the decision of the examiner is affirmed.

Appeal No. 2005-0952  
Application No. 09/908,282

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
JOHN P. MCQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

CEF/hh

Appeal No. 2005-0952  
Application No. 09/908,282

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